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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,293	03/13/2001	Tadahiro Nakao	KPC-289	9278

7590 01/15/2003  
RADER, FISHMAN & GRAUER, P.L.L.C.  
1233 20th Street, NW, Suite 501  
Washington, DC 20036

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/15/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

**Office Action Summary**

Application No.

09/804,293

Applicant(s)

NAKAO ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 10-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

The substitute specification filed August 13, 2001 (Paper No. 8) remains under objection pursuant to 35 U.S.C. 132. The objection is maintained for the reasons of record set forth in the previous Office action. The arguments filed December 20, 2002 have been considered but are unpersuasive.

Production Examples 5 and 6 of the specification do not correspond to Examples 1 and 4, respectively of the translation for Japanese priority application no. 2000-075653 because of the different amounts of styrene (25 parts in Production Example 5 of the specification vs. 20 parts in Example 5, page 19, paragraph 41 of the Japanese priority application), n-butyl methacrylate (14 parts vs. 25 parts), i-butyl methacrylate (16 parts vs. 10 parts), 2-ethylhexyl acrylate (18 parts vs. 25 parts) and glycidyl methacrylate (27 parts vs. 20 parts) in the polymerization of the vinyl resin.

Production Example 7 of the specification is corroborated by Example 7 of application no. 2000-075653.

Production Example 8 of the specification is supported by Example 8 of application no. 2000-075653.

Production Example 10 is substantiated by Example 2 of application no. 2000-075653.

Production Example 11 of the specification is corroborated by Example 3 of application no. 2000-075653.

Example 5 on page 29 of the specification corresponds to Example 1, page 20, paragraph 42 except for the use of 1.0% by weight of lead naphthenate in Example 5 (line 7) vs. 0.1% by weight in Example 1 (line 11).

Example 6 in Table 2 on page 30 of the specification is supported by Example 2 on pages 20-21 of application no. 2000-075653 except for the content of lead naphthenate as set forth in the previous paragraph. However, the formula for FANCRYL FA-512MT depicted on page 20 of the Japanese priority application should be inserted into page 24, after line 18 of the specification for proper enablement.

Example 7 in Table 2 of the specification is substantiated by Example 3 on pages 21-22 of application no. 2000-075653 except for level of lead naphthenate as described hereinabove.

Example 8 in Table 2 of the specification is corroborated by Example 4 on page 22 of application no. 2000-075653 except for the quantity of lead naphthenate as espoused hereinabove.

Example 9 in Table 2 of the specification is supported by Example 5 on page 22 of application no. 2000-075653 except for the proportion of lead naphthenate as explained hereinabove.

Example 10 in Table 2 of the specification is not substantiated by Example 6 on page 22 of application no. 2000-075653 because Example 6 contains 70% by weight of Urethane-modified vinyl resin and 0.1% by weight of lead naphthenate vs. 50% by weight and 1.0% by weight, respectively, in Example 10 as exhibited in Table 2.

Example 11 in Table 2 of the specification is corroborated by Example 7 on pages 23-24 of application no. 2000-075653 except for the amount of lead naphthenate as disclosed hereinabove.

Example 12 in Table 2 of the specification is supported by Example 8 on pages 24-25 of application no. 2000-075653 except for the content of lead naphthenate as discussed hereinabove.

Comparative Example 2 in Table 2 of the specification is substantiated by Comparative Example 1 on pages 25-26 of application no. 2000-075653 except for the level of lead naphthenate which is absent from Comparative Example 1.

Comparative Example 3 in Table 2 of the specification is not supported by Comparative Example 3 on pages 26-27 of application no. 2000-075653 since the polymer dispersion of Example 3 utilized in Comparative Example 3 and described on pages 21-22 of application no. 2000-075653 does not correspond to Polymer dispersion B-1 of Comparative Example 3 which is disclosed on page 22, line 26, Production Example 9 (labeled as polymer dispersion (B-1) on page 23, lines 27-28).

Table 3 on page 31 of the specification corresponds to Table 1 on page 30 of application no. 2000-075653.

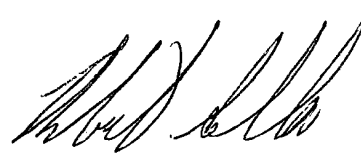
Claims 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

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The election filed December 20, 2002 is incomplete due to the lack of a response to the election of species propounded on pages 4-5 of the restriction and election of species requirement mailed November 20, 2002 (Paper No. 9). The election of a particular species of urethane modified vinyl resin (A) such as the glycidyl methacrylate/styrene/n-butyl methacrylate/i-butyl methacrylate/2-ethylhexylmethacrylate as epoxy group-containing vinyl copolymer (a), linseed oil fatty acids as fatty acid (b) and hexamethylene diisocyanate as isocyanate group-possessing compound (c) shown in Production Example 1 on pages 16-17 of the specification would satisfy the requirement.

The election filed on December 20, 2002 is not fully responsive to the prior Office Action because of the lack of response to the election of species requirement as explained in the previous paragraph. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

(703) 308-2399 (Fax no. (703) 872-9310)  
Monday to Friday from 9:30 to 6:00 EST



Robert Sellers  
Primary Examiner  
Art Unit 1712

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1/14/03